

PATENT
81926.0005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent 7,049,071

Inventors: WALMSLEY, et al.

Issued: May 23, 2006

Appln. No.: 10/244,292

Filed: September 16, 2002

For: Detection of DNA Damaging Agents

Art Unit: 1636

Examiner: McKelvey, T.A.

Confirmation No.: 6525

REQUEST FOR CERTIFICATE OF CORRECTION

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Request is hereby made for correction of the subject Letters Patent. This patent, which is a continuation of US 6,489,099, is assigned to Gentronix Limited. The assignment from University of Manchester Institute of Science and Technology was recorded against the parent patent at Reel/Frame 011454/0773 on January 17, 2001.

However, on the issue fee transmittal dated December 13, 2005, applicant mistakenly listed University of Manchester Institute of Science and Technology as the name of the assignee, which in turn was printed on the published patent. Gentronix Limited, however, is the correct assignee and applicant respectfully requests correction of same.

As this is applicant's error, please charge the fee of \$100 due, and any additional fees due to Deposit Account No. 50-1314 of the undersigned attorney's firm.

Copies of this Request, the requested Certificate of Correction, and the Notice of Recordation of Assignment Document are enclosed.

Respectfully submitted,

HOGAN & HARTSON L.L.P.

Date: February 2, 2007

By: 

Troy M. Schmelzer
Registration No. 36,667
Attorney for Applicant(s)

1999 Avenue of the Stars, Suite 1400
Los Angeles, California 90067
Telephone: 310-785-4600
Facsimile: 310-785-4601

(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

PATENT NO : 7,049,071

DATED : May 23, 2006

INVENTOR(S): WALMSLEY, et al.

It is certified that error appears in the above-identified patent and that said Letters Patent are hereby corrected as shown below:

On the Front Page, Col. 1, line 73 (Assignee Section), change "University of Manchester Institute of Science and Technology" to **-Gentronix Limited--**.

MAILING ADDRESS OF SENDER: Troy M. Schmelzer, Reg. No. 36,667
Hogan & Hartson LLP
1999 Avenue of the Stars, Suite 1400
Los Angeles, CA 90067

PATENT NO. 7,049,071

No. of additional copies

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Patent and Trademark Office
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Washington, D.C. 20231
34920-0001

APRIL 05, 2001

PTAS

HOGAN & HARTSON LLP
LOUIS A. MOK, ESQ.
500 SOUTH GRAND AVENUE, SUITE 1900
LOS ANGELES, CA 90071



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UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 01/17/2001

REEL/FRAME: 011454/0773

NUMBER OF PAGES: 14

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

MANCHESTER INSTITUTE OF SCIENCE
AND TECHNOLOGY, UNIVERSITY OF,
THE

DOC DATE: 07/21/1999

ASSIGNEE:

GENTRONIX LIMITED
C/O UVL, THE FAIRBAIRN BUILDING
72 SACKVILLE STREET
MANCHESTER, STATELESS M60 1 QD

SERIAL NUMBER: 09381989

FILING DATE: 01/12/2000

PATENT NUMBER:

ISSUE DATE:

TONYA LEE, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

RECEIVED
APR 11 2001
DOCKETING

01-29-2001



TTTER

1.17.01

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Attorney Docket No.: 81926.0001

To the Assistant Commissioner for Patents: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

The University of Manchester Institute of Science and Technology

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment

Execution Date: July 21, 1999

2. Name and address of receiving party(ies):

GENTRONIX LIMITED
c/o UVL, The Fairbairn Building
72 Sackville Street
Manchester M60 1 QD

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s) 09/381,989

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Louis A. Mok, Esq.
HOGAN & HARTSON L.L.P.
500 South Grand Avenue, Suite 1900
Los Angeles, CA 90071

6. Total number of applications and patents involved: [1]

7. Total fee (37 CFR 3.41) \$40.00

☒ Enclosed
☐ Authorized to be charged to deposit account

8. Deposit account number:

50-1314

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing is true and correct and any attached copy is a true copy of the original document.

Louis A. Mok

Date: January 12, 2001

OMB No. 0651-0011 (exp. 4/94)

Mail documents to be recorded with required cover sheet information to:

Assistant Commissioner for Patents
Box Assignments
Washington, D.C. 20231

01/26/2001 GTON11 00000197 09381989

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40.00 0P

ASSIGNMENT OF INTELLECTUAL PROPERTY RIGHTS

DATED this 21st day of July 1999

BETWEEN:

- (1) **THE UNIVERSITY OF MANCHESTER INSTITUTE OF SCIENCE AND TECHNOLOGY** of PO Box 88, Manchester M60 1QD ('the Assignor')
- (2) **GENTRONIX LIMITED** a company registered in England under Number 3810162 whose registered office is at c/o UVL, The Fairbairn Building, 72 Sackville Street, Manchester M60 1QD ('the Assignee')

Recitals

- (A) The Assignor is the beneficial owner of the rights of confidence in and has possession of a substantial body of valuable Technical Information (as defined below) relating to an Invention (as defined below).
- (B) The Assignor enters into this agreement, in part, in consideration for the allotment of shares in the Assignee.
- (C) It is understood by the parties that the Invention has commercial applications and a patent application has been made.
- (D) The Assignor has agreed to assign to the Assignee all Intellectual Property Rights (as defined below) and rights in the Technical Information (as defined below).

Operative Provisions

1. Definitions

In this Assignment the following terms shall have the following meanings unless the context otherwise requires:

"Copyright"

all copyright and rights in the nature of copyright to which either party may now be or may subsequently become entitled in or in respect of all drawings and other documents, recordings in any form and all other materials bearing or embodying any part of the Technical Information including without limitation any such materials consisting of or containing software or databases;

"Invention"

The detection of DNA damage and stress utilising Green Fluorescent Protein Reporters;

"Intellectual Property Rights"

all copyrights, moral rights, related rights, patents, supplementary protection certificates, petty patents, brevets d'invention, utility models, trade marks, service marks, designs rights, registered designs, database rights, rights in unfair competition, rights in undisclosed or confidential information (such as know-how, trade secrets and inventions (whether patentable or not)) and other similar intellectual property rights (whether registered or not) and applications for such rights as may exist elsewhere in the world which relate to the Invention or the Products and which, for the avoidance of doubt, includes the PCT patent application GB 98/00786 and all rights assigned to the Assignor by an earlier assignment dated 31st July 1998 between Dr R M Walmsley or 159 Oswald Road, Chorlton, Manchester M21 9AZ and the Assignor a copy of which is annexed hereto as Annexure 1.

"Products"

those items produced which employ the Invention in their operation;

"Technical Information"

all identifiable know-how, experience, data and all other technical or commercial information relating to the Invention whether in human or machine readable form and whether stored electronically or otherwise and which might reasonably be of commercial interest to either party in the design, manufacture or supply of the Products or in the operation of the Invention;

2. Assignment

- 2.1 In consideration of 1 (one) pound the Assignor **HEREBY ASSIGNS** and transfers to the Assignee absolutely free from all liens, charges, security interests and/or encumbrances whatsoever:

- 2.1.1 all and any rights in and to the Intellectual Property Rights together with any common law and statutory rights and all the goodwill associated with, symbolised by or attaching to the Intellectual Property Rights. Such assignment shall include the transfer of all right, title and interest in the Intellectual Property Rights conferred under the laws of the United Kingdom and of all other countries of the world for the remainder of the term during which the said rights and any renewals or extension thereof shall subsist.
- 2.1.2 all rights and title possessed by the Assignor in respect of the Technical Information and the full and unfettered and exclusive world right to use the information for any purpose whatsoever (including the filing of patent applications in respect of all or any part of it);

2.2 The Assignor:

2.2.1 agrees to disclose all the Technical Information known to the Assignor to the Assignee, or any person nominated by the Assignee, and provide all reasonable assistance and information as may be reasonably necessary in order to assist the Assignee, or its nominee, to develop and manufacture the Invention.

2.2.2 agrees not, without the prior written consent of the Assignee:

2.2.2.1 to communicate or otherwise make available the Technical Information to any third party; or

2.2.2.2 to use that Technical Information for any purpose;

2.2.3 warrants that, save for the Assignee, the Assignor is not aware that the Technical Information, or any of it, is known, or as a result of any past action or default on its part, or that of anyone else, is likely to become known to any third parties.

3. Right to bring proceedings

3.1 The Assignment hereby effected shall include the right for the Assignee to bring proceedings against any third party in respect of the Intellectual Property Rights (including proceedings from past infringements of the rights of the Assignor in the Intellectual Property Rights). The Assignor hereby agrees and undertakes to render the Assignee (at its request) all such assistance with proceedings which may be brought by or against the Assignee against or by any third party in relation to the Intellectual Property Rights and the Assignee shall indemnify the Assignor in respect of all costs and expenses (including reasonable legal costs) actually incurred by him in providing the Assignee with such assistance.

4. Assignors' Warranties

4.1 The Assignor warrants to the Assignee in respect of the Intellectual Property Rights as follows:

4.1.1 that the Assignor has given no permission to any third party to use any of them;

4.1.2 that the Assignor is unaware of any use by any third party of any Intellectual Property Rights;

4.1.3 that the Assignor has not made any other assignment or purported assignment of the same or similar Intellectual Property Rights.

5. Waiver of Moral Rights

5.1 The Assignor hereby waives any rights which it may have in any copyright which are granted by Chapter 4 of Part 1 of the Copyrights, Designs and Patents Act 1988 (headed "Moral Rights") or similar rights granted under a foreign jurisdiction.

6. Further Assurance


6.1 The Assignor hereby covenants that at the cost and request of the Assignee at any time and from time to time, it will execute such deeds or documents and do such acts or things as may be necessary or desirable to give effect to this Assignment.

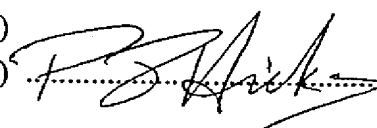
7. Law and Jurisdiction

7.1 This Assignment shall be governed by and construed in accordance with the laws of England and the parties hereto submit to the exclusive jurisdiction of the English Courts.

IN WITNESS WHEREOF the parties have signed this Assignment as a Deed.

SIGNED for and on behalf
of the Assignor in the presence of:

)  Director/Secretary

)
)
)  Director

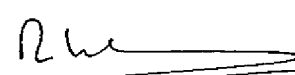
Signature:

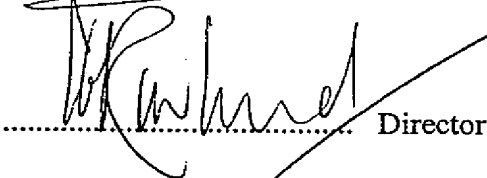
Name:

Address:

Occupation:

SIGNED for and on behalf
of the Assignee in the presence of:

)  Director/Secretary

)
)  Director

ANNEXURE 1

UMIST VENTURES DOCUMENT TYPE 1
EMPLOYEE ASSIGNMENT AND REVENUE SHARING AGREEMENT:
POST INVENTION, NO RESEARCH CONTRACT WITH THIRD PARTY IN PLACE

ASSIGNMENT

THIS ASSIGNMENT is made the Thirty first day of July 1998

BETWEEN

DR. R. M WALMSLEY of 159, Oswald Road, Chorlton, Manchester, M21 9AZ

(hereinafter referred to as the Assignor)

AND

THE UNIVERSITY OF MANCHESTER INSTITUTE OF SCIENCE AND TECHNOLOGY, of P.O. Box 88, Manchester M60 1QD

(hereinafter referred to as the Assignee)

WHEREAS the Assignor in the course of his/her employment by the Assignee/using the facilities of the Assignee and otherwise than in pursuit of a research contract between the Assignee and a third party has made an invention/discovery/design [contributed to the making of an invention/discovery/design] identified in the first schedule to this agreement.

WHEREAS by a decision of the Academic Board of and ratified by Council of the Assignee the Assignee has conceded to the Assignor sole ownership of rights in the said invention/discovery/design in the above circumstances notwithstanding that by operation of law the Assignee is prima facie owner of the rights in the said invention/discovery/design.

WHEREAS in consideration for financial and other assistance in the pursuit of protection and exploitation of the rights in the invention/discovery/design and in consideration for an agreed share of profits resulting therefrom and set out hereinafter the Assignor has agreed to assign all his/her rights in the said invention/discovery/design.

IT IS HEREBY AGREED AS FOLLOWS:

1. The Assignor hereby as beneficial owner assigns all his/her right title and interest in and to the invention/discovery/design identified in the first schedule to this agreement including the right to seek protection through patents, trade secrets, registered and unregistered designs, copyright and allied rights to hold the same unto the Assignee absolutely.
2. The Assignor warrants to the best of his/her knowledge and belief:
 - (a) that the said invention/discovery/design is the result of his/her personal original work;
 - (b) that the said invention/discovery/design has not been published, nor disclosed to any third party otherwise than in confidence;

(c) that the said invention/discovery/design does not reproduce or make use of the work of any third party including fellow employees and/or students of the Assignee [save to the extent disclosed in the second schedule to this agreement];

(d) that the use or application of the said invention/design/discovery does not infringe the intellectual property rights of any third party including fellow employees and/or students of the Assignee [save to the extent disclosed in the second schedule to this agreement];

(e) that the disclosure or use of the said invention/design/discovery does not breach any obligation of confidence owed to any third party including fellow employees and/or students of the Assignee [save to the extent disclosed in the second schedule to this agreement].

and the Assignor agrees to indemnify the Assignee for any loss or damage suffered by the Assignee as a result of breach of these warranties by the Assignor.

3. The Assignor agrees not to disclose to any third party without the prior consent in writing of an authorised officer of the Assignee any information, notes, drawings or other materials relating to the said invention/discovery/design save for information already in the public domain at the date of this agreement.

4. The Assignor agrees to execute any documents and do all things reasonably necessary to assist the Assignee in its pursuit and acquisition and defence and enforcement of any patents, trade secrets, registered and unregistered designs, copyright and allied rights in respect of the invention as the Assignee may see fit and request (including the provision of information in the possession of the Assignee) without charge to the Assignee save for the out of pocket expenses of the Assignor reasonably incurred at the request of the Assignee.

5. The Assignor agrees not to oppose the grant of any right in the said invention/discovery/design to the Assignee or dispute the validity of such right or the ownership of such right.

6. The Assignee agrees to consider the appropriate steps to be taken in protecting and exploiting the said invention/design/discovery and to take such steps if any as it deems fit in all the circumstances to protect and exploit the said invention/discovery/design.

7. The Assignee agrees to make available to the Assignor a proportion of the net revenue arising from the invention/discovery/design (after deduction of expenses incurred by the Assignee and set out in clause 8 below and after deduction of any income taxes payable by the Assignor which must be withheld) arising from the exploitation of the invention/discovery/design in accordance with the following provisions:

(a) in cases where no other rightful claims exist to the rights in the said invention/discovery/design,

CUMULATIVE NET REVENUE

PERCENTAGE PAYABLE TO Assignor

The first £5,000

80 per centum of net revenue

The next £15,000

66²/₃ per centum of net revenue

Thereafter

50 per centum of net revenue

(b) in cases where there are other rightful claims to the rights in the said invention/discovery/design such proportion of the sums which would be payable to the Assignor under (a) above as is set out in the third schedule to this agreement.

8. The expenses which the Assignee may deduct in calculating the net revenue arising from the said invention/discovery/design are:

- the expenses and costs incurred in seeking and/or obtaining legal protection for the invention/discovery/design and enforcing and defending the rights resulting therefrom
- the expenses and costs incurred in developing into a marketable condition, promoting, making or manufacturing and marketing the invention/discovery/design
- the expenses incurred in negotiating and administering agreements for the exploitation of the invention/discovery/design including any licences or assignments from third party of rights necessary or desirable for the exploitation of the said invention/discovery/design
- which expenses shall in all cases include the cost of provision of the staff and amenities of the Assignee and third party fees and charges incurred by the Assignee in performing the acts identified in this clause.

9. The undertakings and warranties given herein shall enure to the benefit of and bind the successors in title to the parties hereto.


10. The Assignor and Assignee agree that any dispute as to the meaning or interpretation of this agreement which cannot be resolved by agreement shall be referred to an independent arbitrator acceptable to both parties or in the absence of agreement thereon to the Official Referee, and the Assignor and the Assignee hereby agree to abide by the decision of the independent arbitrator or Official Referee as the case may be.

11. This agreement shall be governed by and interpreted in accordance with the laws of England and Wales.

EXECUTED BY THE Assignor


.....
DR. R.M. WALMSLEY

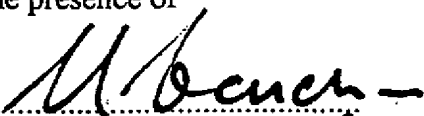
in the presence of


.....
M. A. COGLAN

EXECUTED ON BEHALF OF THE Assignee


.....

in the presence of


.....

THE FIRST SCHEDULE

1. NATURE OF Invention/discovery/design

Green Fluorescent Protein Reporters for DNA damage and stress

2. DATE OF Invention/discovery/design 3-12-96

3. BRIEF DESCRIPTION OF Invention/discovery/design

See patent application 9706414

4. SUMMARY OF CIRCUMSTANCES IN WHICH IT AROSE

My idea for a genetic screen to be part of a the activities of EUROFAN2.

initialled by Assignor.....*rw*

THE SECOND SCHEDULE

1. SOURCES OF FUNDING/FACILITIES USED IN CONDUCTING THE RESEARCH

BBSRC, CEC

2. RELEVANT PRIOR RESEARCH OF WHICH Assignor IS AWARE

See patent application 9706414

3. RELEVANT THIRD PARTY RIGHTS OF WHICH Assignor IS AWARE

GFP patents held by Roger Tsein/Arora, USA

4. OTHER COLLABORATORS TO THE RESEARCH/CONTRIBUTORS TO THE
Invention/discovery/design

Dr Wolf-Dietrich HEYER
Section of Microbiology
One Shields Ave
University of California, Davis
USA

initialled by Assignor *aw*

THE THIRD SCHEDULE

The distribution to the Assignor of the net revenue share accumulating under this agreement shall be as set out below in place of the share set out in clause 7(a) of the agreement:

| CUMULATIVE NET REVENUE | PERCENTAGE PAYABLE TO Assignor |
|------------------------|--|
| The first £5,000 | per centum of net revenue * |
| The next £15,000 | per centum of net revenue * |
| Thereafter | per centum of net revenue * |

* 10% of net revenue to RMW according to clause 7a goes to Dr Heyer 9(second schedule, 4)